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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/755,832	01/12/2004	Viktors Berstis	AUS920030667US1	9835

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EXAMINER	
NGUYEN, PHILLIP H	
ART UNIT	**PAPER NUMBER**
2191	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/755,832	BERSTIS ET AL.	
	Examiner	Art Unit	
	Phillip H. Nguyen	2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20040112*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the original filing date of January 12, 2004. Claims 1-14 are pending and considered below.

Note

2. Regarding those claims recite the phrases "for" or "adapted to" in the preamble or the body of the claim. It indicates intended use and as such do not carry any patentable weight. Limitations following the phrase "for" or "adapted to" describe the intended use but not necessarily required functionality of the claim. Applicant is required to amend those claims so that the limitations are recited in a definite form. For example, claim 9 states "adapted to identify" should be changed to "identifies" or "to identify"

Specification

3. The incorporation of essential material in the specification by reference to a patent application numbers 10/455,159 is improper (page 1). Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 5, and 9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 12, and 22 of copending Application No. 10/865,347. Although the conflicting claims are not identical, they are not patentably distinct from each other because limitations in one claim can obviously be applicable in the corresponding claim.

The following tables show few claims to demonstrate the reason for rejection.

Application No. 10/755,832	Application No. 10/865,347
1. A method for transferring content from one computer resource to another	12. A method for transferring computer-readable image content from one

computer resource, comprising the steps of: - intercepting the transfer of one or more information elements selected from a source to a destination; - determining if each intercepted information element is expressed in a natural language which matches a user-specified natural language; - performing one or more natural language handling actions on information elements which do not match said user specified natural language as defined by one or more natural language handling rules; and - transferring any information elements to said destination which have been translated to said user specified natural language as a result of said handling actions.	computer resource to another computer resource, comprising the steps of: - intercepting the transfer of a source image element from a computer-readable source to a computer-readable destination; - determining if each embedded text instance is expressed in a natural language which matches a user-specified destination natural language; - performing natural language translation of one or more embedded text instances which do not match said user specified destination natural language; and - transferring said modified image element to said computer readable destination.
5. A computer readable medium encoded	22. One or more computer-readable media

with software for transferring content from one computer resource to another computer resource, said software performing the steps of: - intercepting the transfer of one or more information elements selected from a source to a destination; - determining if each intercepted information element is expressed in a natural language which matches a user-specified natural language; - performing one or more natural language handling actions on information elements which do not match said user specified natural language as defined by one or more natural language handling rules; and - transferring any information elements to said destination which have been translated to said user specified natural language as a	encoded with software for transferring computer-readable image content from one computer resource to another computer resource, said software performing the steps of: - intercepting the transfer of a source image element from a computer-readable source to a computer-readable destination; - determining if each embedded text instance is expressed in a natural language which matches a user-specified destination natural language; - performing natural language translation of one or more embedded text instances which do not match said user specified destination natural language; and - transferring said modified image element to said computer readable destination

result of said handling actions.	
9. A cut-and-paste system for transferring content from one computer resource to another computer resource, comprising: - an information transfer interceptor configured to intercept one or more information elements in transit from a source to a destination via a transfer buffer; - a natural language comparator adapted to identify which intercepted information elements are not originally expressed in a natural language which matches a user-specified natural language; - a natural language handler which performs one or more natural handling actions on said identified information elements as defined by one or more handling rules; and - an information element deliverer configured to transfer information	1. A system for transferring computer-readable image content from one computer resource to another computer resource, comprising: - an image element interceptor configured to intercepting the transfer of a source image element from a computer-readable source to a computer-readable destination; - a source language identifier configured to determine if each text instance is expressed in a natural language which matches a user-specified destination natural language; - a translator configured to perform natural language translation of one or more text, instance which do not match said user specified destination natural language; and - an output for transferring said

elements to said destination as defined by one or more handling rules.	modified image element to said computer readable destination.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1, 5 and 9-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 1 and 5, raise a question as to whether the claims are directed to an abstract idea that is not tied to a technological art, environment or machine which would accomplished a practical application producing a **concrete, useful, and tangible result** to form the basis of statutory subject matter under 35 U.S.C. 101. For instance, claim 1 states "determining if each intercepted information element is expressed in a natural language which matches a user-specified natural language" raises a question as to whether the translating step and the transferring step are going to perform when the outcome of the determining step is matched. Since the translating step only performs when there are information elements that do not match the specified natural language. Further more, the transferring step transfers only the translated information.

Regarding claim 9-14, recite a cut-and-paste system but it appears reasonable to interpret this system by one of ordinary skill in the art as software, per se. Applicant's specification provides no explicit and deliberate definition of the components ("information transfer interceptor", "natural language comparator", "natural language handler", and "information element deliver") that make up the system other than they could be software components, which are directed to functional descriptive material, per se, and are therefore non-statutory.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1 and 5are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 5, recite "if each intercepted information element is expressed in a natural language which matches a user specified natural language" is unclear to Examiner as to whether the translating step and the transferring step are performed when the result of determining step is matched. Applicant is required to amend the claim to eliminate the alternative path produced by the "if..." statement.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 2, 5, 6, 9, 10, and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Barnes et al. (United States Patent No.: 5,974,372).

As per claim 1:

Barnes discloses a method for transferring content from one computer resource to another computer resource, comprising the step of:

- intercepting the transfer of one or more information elements selected from a source to a destination ("**intercepts the window/screen message prior to delivery**" col. 5, line 25);
- determining if each intercepted information element is expressed in a natural language which matches a user-specified natural language ("**intercepts the window/screen message prior to application delivery to see whether the screen display has been previously hooked i.e. translated**" col. 5, line 25-26, **if it has been translated, it means that the languages are not matched**);
- performing one or more natural language handling actions on information elements which do not match said user-specified natural language as defined

by one or more natural language handling rules ("**the window text is extracted from the message and forwarded to a translation routine**" col. 5, line 26-28); and

- transferring any information elements to said destination which have been translated to said user specified natural language as a result of said handling actions ("**the message sent to the downstream presentation manager for display includes the translated text, such message being displayed on the user's terminal in lieu of the original basic language message**" col. 5, line 29-32).

As per claim 2:

Barnes discloses the method as in claim 1 above; and further discloses:

- wherein said handling actions comprise isolating certain information elements according to said handling rules ("**window text is extract from the message**" col. 5, line 26), thereby blocking their transfer to said destination (**message is a block of text**).

As per claims 5 and 6:

- computer readable medium claims, recite the same limitations as recited in claims 1 and 2, respectively, and therefore, have been addressed in connection with the rejection set forth to claim 1 and 2, respectively.

As per claims 9 and 10:

- system claims, recite the same limitations as recited in claims 1 and 2, respectively, and therefore, have been addressed in connection with the rejection set forth to claims 1 and 2, respectively.

As per claim 12:

Barnes discloses the method as in claim 9 above; and further discloses:

- a rule management user interface for allowing, a user to define an actions to be taken on designed types of information elements, including at least one action selected from the group of creation of new handling rule, deleting a handling rule, copying a handling rule, and modifying a handling rule ("**if a foreign translation of the basic language is desired, the mouse is dragged to this ICON 2010. Upon double clicking the mouse on this ICON 2010, screen displays are presented requiring the user to enter certain data utilized by the logic of the underlying translator program 1000**" col. 4, line 4-8; **this is a new rule the user sets up when translating foreign language**).

As per claim 13:

Barnes discloses the method as in claim 12 above; and further discloses:

- wherein said rule management user interface is manually invoked by said user ("**upon double clicking the mouse**" col. 4, line 5).

As per claim 14:

Banes discloses the method as in claim 12 above; and further discloses:

- wherein said rule management user interface is automatically invoked responsive to finding no existing natural language handling rule for an intercepted information element ("**if the user desires that an automatic translation of all screen...**" col. 4, line 53).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 3, 4, 7, 8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes (United States Patent No.: 5,974,372).

As per claim 3:

Barnes discloses the method as in claim 1 above; and further discloses:

- subsequently invoking a computer translation process to translate each item from the said original natural language to said user-specified natural language ("**the widow text is extracted from the message, forwarded to a translation routine**" col. 5, line 26-27).

Barnes does not explicitly disclose:

- determining an original natural language in which each intercepted information elements is expressed.

However, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify Barnes's approach to include determining the original natural language step. One of ordinary skill would have been motivated to modify Barnes's approach in order to fulfill the translation routine because the original langue can be any of the natural languages (e.g., English, Japanese, Spanish, German...) and the destination language can be any of the mentioned languages.

As per claim 11:

- system claim, recites the same limitations as recited in claim 3 above, and therefore, has been addressed in connection with the rejection set forth to claim 3.

As per claim 4:

Barnes discloses the method as in claim 1 above; and further discloses:

- invoking a rule management user interface responsive to finding no existing natural language handling rule for an information element to be transferred ("**upon double clicking the mouse on this ICON 2010, screen displays are presented requiring the user to enter certain data utilized by the logic of the underlying translator program 1000**" col. 4, line 5-8; also see FIGS. 13 and 16);

- allowing, via said rule management user interface, a user to define an action to be taken selected from the list of invoking a natural language translation process ("**if a foreign translation of the basic language is desired, the mouse is dragged to this ICON 2010. Upon double clicking the mouse on this ICON 2010, screen displays are presented requiring the user to enter certain data utilized by the logic of the underlying translator program 1000**" col. 4, line 4-8); and
- isolating said information element ("**window text is extracted from the message**" col. 5, line 26).

Barnes does not explicitly disclose:

- allowing transfer without modification.

However, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to recognize that the translated text is not modified from it original text. It has been translated to different natural language but not modified otherwise it will defeat the purpose of translation.

As per claims 7 and 8:

- computer readable medium claims, recite the same limitations as recited in claim 3 and 4, respectively, and therefore, have been addressed in connection with the rejection set forth to claim 3 and 4 respectively.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip H. Nguyen whose telephone number is (571) 270-1070. The examiner can normally be reached on Monday - Thursday 10:00 AM - 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y. Zhen can be reached on (571) 272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PN
02/26/2007

WEI ZHEN
SUPERVISORY PATENT EXAMINER